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APPLICATION NO..	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/636,039	08/09/2000	Jamey Graham	15358-004240US	5597

20350 7590 09/17/2004

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EXAMINER	
CAMPBELL, JOSHUA D	
ART UNIT	**PAPER NUMBER**
2179	

DATE MAILED: 09/17/2004

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/636,039	GRAHAM ET AL.	
	Examiner	Art Unit	
	Joshua D Campbell	2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 July 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4-21 and 23-41* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4-21 and 23-41* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *12 and 14*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: Amendment filed on 07/15/2004 and IDS filed on 07/15/2004 and 07/19/2004.

2. Claims 1-2, 4-21, and 23-41 are pending in this case. Claims 1, 11, 19, 20, 30, and 38-41 are independent claims. Claims 3 and 22 have been cancelled and claims 1-2, 4-21, and 23-41 have been amended.

3. The rejection of claims 1, 3, 6-8, 20, 22, and 25-27 under 35 U.S.C. 102(e) as being anticipated by Okamoto et al. has been withdrawn in view of the amendments.

4. The rejection of claims 2, 5, 21, and 24 under 35 U.S.C. 103(a) as being unpatentable over Okamoto et al. in view of Gounares et al. has been withdrawn in view of amendments.

5. The rejection of claims 4 and 23 under 35 U.S.C. 103(a) as being unpatentable over Okamoto et al. in view of msdn online Web Workshop has been withdrawn in view of amendments.

6. The rejection of claims 9-10 and 28-29 under 35 U.S.C. 103(a) as being unpatentable over Okamoto et al. in view of Schultz has been withdrawn in view of amendments.

7. The rejection of claims 14-16 and 33-35 under 35 U.S.C. 103(a) as being unpatentable over Rowe et al. in view of Okamoto has been withdrawn in view of amendments.

8. The rejection of claim 19 and 38-41 under 35 U.S.C. 103(a) as being unpatentable over Rowe et al. in view of Okamoto has been withdrawn in view of amendments.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 20, 22, and 39 are rejected under 35 U.S.C. 102(e) as being anticipated by Nielsen (US Patent Number 6,339,437, filed on September 30, 1997).

In regard to independent claim 1, Nielsen discloses a method in which a document is accessed and it is searched to identify text patterns that are relevant to user queries (plurality of concepts), which are received from the user (column 1, line 17-column 2, line 16 of Nielsen). Nielsen discloses a method in which search terms are supplied via user queries and a document is searched to identify text patterns that match those search terms (column 1, line 17-column 2, line 16 of Nielsen). The text patterns that match the queries are then marked using tags and highlighted with color

(annotated) to emphasize their position as the document is viewed (column 1, line 17-column 2, line 16 of Nielsen).

In regard to independent claim 20 and dependent claim 22, the claims incorporate substantially similar subject matter as claims 1 and 3. Thus, the claims are rejected along the same rationale as claims 1 and 3.

In regard to independent claim 39, the claim incorporates substantially similar subject matter as claim 1. Thus the claim is rejected along the same rationale.

11. Claims 11-13, 17-18, 30-32, and 36-37 remain rejected under 35 U.S.C. 102(b) as being anticipated by Rowe et al. (US Patent Number 5,737,599, issued on April 7, 1998 - IDS).

In regard to independent claim 11, Rowe discloses a method in which a multi-page document is accessed and a section of that document is shown in a first area and thumbnails of the entire document are displayed in a second area (Figure 2b and column 12, lines 26-36 of Rowe). Rowe also discloses a method in which information about the contents of a document; including dimensions and locations of items (coordinates) are determined (Figure 15a-d and column 37, line 10-column 41, line 11 of Rowe). Rowe also discloses that the portion of the thumbnail window corresponding to the part of the document being displayed is highlighted (emphasized) (column 12, lines 26-36 of Rowe).

In regard to dependent claim 12, Rowe discloses a method in which information about the contents of a document, including dimensions and locations of

items (coordinates) are determined so that when a portion of the thumbnail window is selected the correct section of the document can be downloaded for display (Figure 2b and column 12, lines 26-36 of Rowe).

In regard to dependent claim 13, Rowe discloses a method in which document correspondence between thumbnail and full image is based on a denominator used to divide the page contents (Figure 15a-d and column 37, line 10-column 41, line 11 of Rowe).

In regard to dependent claim 17, Rowe discloses a method in which determining information about a document (coordinates and dimension) for creating thumbnail representations of the document incorporate all formatting of that document including forms (column 11, line 66-column 12, line 36 of Rowe).

In regard to dependent claim 18, Rowe discloses a method in which determining information about a document (coordinates and dimension) includes determining information about text, forms, graphics, images, and links (column 11, line 66-column 12, line 36 of Rowe).

In regard to independent claim 30 and dependent claims 31-32 and 36-37, the claims incorporate substantially similar subject matter as claims 11-13 and 17-18. Thus, the claims are rejected along the same rationale as claims 11-13 and 17-18.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 2, 5, 21, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen (US Patent Number 6,339,437, filed on September 30, 1997) as applied to claims 1 and 20 above, and further in view of Gounares et al. (hereinafter Gounares, US Patent Number 6,681,370, filed on May 19, 1999).

In regard to dependent claims 2 and 21, Nielsen does not disclose a method in which the searching and marking of the document is performed using a Document Object Model configured by Internet Explorer. However, Gounares discloses a method in which a document that is converted into a Document Object Model tree using a web browser (i.e. Internet Explorer) to make changes to specific locations in a document by finding the location (searching) and editing the location (marking) (column 2, line 63-column 4, line 27 of Gounares). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of searching a

document of Nielsen with the method of using a DOM tree to edit a document of Gounares because it would have provided a set standard of modeling, interfacing and manipulating the documents that are being marked.

In regard to dependent claims 5 and 24, Nielsen does not disclose a method in which the searching and marking of the document is performed using IMarkupServices interface configured by Internet Explorer. However, Gounares discloses a method in which a document that is converted into a Document Object Model tree using a web browser (i.e. Internet Explorer) to make changes to specific locations in a document by finding the location (searching) and editing the location (marking) (column 2, line 63-column 4, line 27 of Gounares). Gounares also discloses that IMarkupServices interface is used to insert tags into the document to edit the appearance (mark) (column 10, lines 8-59 of Gounares). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of searching a document of Nielsen with the method of using a DOM tree with IMarkupServices to edit a document of Gounares because it would have provided a set standard of modeling, interfacing and manipulating the documents that are being marked.

15. Claims 4 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen (US Patent Number 6,339,437, filed on September 30, 1997) as applied to claims 1 and 20 above, and further in view of msdn online Web Workshop (published online on April 20, 2000).

In regard to dependent claims 4 and 23, Nielsen does not disclose a method in which IHTMLTxtRange Interface is used to perform the searching and marking of a

document. However, msdn Online Web Workshop discloses that the IHTMLTxtRange interface is used to retrieve and modify text in an element, locate specific strings in the text, and carry out commands that affect the appearance of the text (i.e. search and mark) (Remarks Section of msdn Online Web Workshop). It would have been obvious to one of ordinary skill in the art to combine the method of searching of Nielsen with the method of searching and marking disclosed by msdn Online Web Workshop because it would have allowed for a simple interface to search and modify both plain text and HTML.

16. Claims 6-8 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen (US Patent Number 6,339,437, filed on September 30, 1997) as applied to claims 1 and 20 above, and further in view of Okamoto et al. (hereinafter Okamoto, US Patent Application Publication Number 2002/0065814, US Filing date June 30, 1999).

In regard to dependent claims 6-8, Nielsen does not disclose a method in which tags are inserted into the document surrounded relevant text that identify what query the tag is in response to, by both tag id and color/style of the highlight that is set to correspond to each specific query. However, Okamoto discloses a method in which tags are inserted into the document surrounded relevant text that identify what query the tag is in response to, by both tag id and color/style of the highlight that is set to correspond to each specific query (page 11, paragraph 0245-0255 of Okamoto). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of viewing a document by Nielsen with the method of searching a document by Okamoto because it would have provided a user with a

simple way to search and customize the identification of terms when viewing a document.

In regard to dependent claims 25-27, the claims incorporate substantially similar subject matter as claims 6-8. Thus, the claims are rejected along the same rationale as claims 6-8.

17. Claims 9-10 and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen (US Patent Number 6,339,437, filed on September 30, 1997) as applied to claims 1 and 20 above, and further in view of Schultz (US Patent Number 5,721,902, issued on February 24, 1998).

In regard to dependent claims 9 and 10, Nielsen does not disclose a method in which scores are calculated for the concepts in a document based on a frequency of text patterns that are relevant to the specific concepts. Nielsen also does not disclose a method in which a relevance indicator is displayed based on relevance score calculations. However, Schultz discloses a method in which relevance scores are determined based on the frequency that the query terms appear in a document (column 25, line 5-column 26, line 20 of Schultz). Schultz also discloses that a graphical representation providing the results or the relevance scoring is provided to the user (column 25, line 5-column 26, line 20 of Schultz). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of searching by Nielsen with the method of ranking relevance of a document based on search terms by Schultz because it would have provided a user with a visual representation of the relevance of a document to the query terms.

In regard to dependent claims 28 and 29, the claims incorporate substantially similar subject matter as claims 9 and 10. Thus, the claims are rejected along the same rationale as claims 9 and 10.

18. Claims 14-15 and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rowe et al. (US Patent Number 5,737,599, issued on April 7, 1998) as applied to claims 11 and 30 above, and further in view of Nielsen (US Patent Number 6,339,437, filed on September 30, 1997).

In regard to dependent claim 14, Rowe discloses a method in which information (coordinates and dimension) about objects in a document (text, graphics, images, and links) are determined (column 11, line 66-column 12, line 36 of Rowe). Rowe does not disclose that text entities are annotated according to style information if they are relevant to any of a plurality of concepts. However, Nielsen discloses a method in which a document is accessed and it is searched to identify text patterns that are relevant to user queries (plurality of concepts), which are received from the user (column 1, line 17-column 2, line 16 of Nielsen). Nielsen discloses a method in which search terms are supplied via user queries and a document is searched to identify text patterns that match those search terms (column 1, line 17-column 2, line 16 of Nielsen). The text patterns that match the queries are then marked using tags and highlighted with color (annotated) to emphasize their position as the document is viewed (column 1, line 17-column 2, line 16 of Nielsen). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of viewing a document by Rowe with the method of searching a document by Nielsen because it

would have provided a user with a simple way to search and identify terms when viewing a document.

In regard to dependent claim 15, Rowe discloses a method in which the thumbnail representations of the document incorporate all formatting of that document which would include highlighted text entities (column 11, line 66-column 12, line 36 of Rowe).

In regard to dependent claims 33-34, the claims incorporate substantially similar subject matter as claims 14-15. Thus, the claims are rejected along the same rationale as claims 14-15.

19. Claims 16 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rowe et al. (US Patent Number 5,737,599, issued on April 7, 1998) in view of Nielsen (US Patent Number 6,339,437, filed on September 30, 1997) further in view of Okamoto et al. (hereinafter Okamoto, US Patent Application Publication Number 2002/0065814, US Filing date June 30, 1999).

In regard to dependent claim 16, neither Rowe nor Nielsen disclose a method in which the style information relevant to a concept is modified and in response all entities that correspond to that concept are changed to correspond with the new style information. However, Okamoto discloses a method in which a concept tag number, which corresponds to one of a plurality of concepts, is directly associated with a specific style (page 12, paragraph 0270-0276 of Okamoto). When that style information is changed all tags corresponding to the tag number associated with that style information will reflect that change (page 12, paragraph 0270-0276 of Okamoto). It would have

been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of viewing a document by Rowe with the method of searching a document by Okamoto because it would have provided a user with a simple way to search and customize the identification of terms when viewing a document.

In regard to dependent claim 35, the claim incorporates substantially similar subject matter as claim 16. Thus, the claim is rejected along the same rationale as claim 16.

20. Claims 19, 38, and 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rowe et al. (US Patent Number 5,737,599, issued on April 7, 1998) in view of Nielsen (US Patent Number 6,339,437, filed on September 30, 1997).

In regard to independent claim 19, Rowe discloses a method in which a multi-page document is accessed and a section of that document is shown in a first area and thumbnails of the entire document are displayed in a second area (Figure 2b and column 12, lines 26-36 of Rowe). Rowe also discloses a method in which information about the contents of a document; including dimensions and locations of items (coordinates) are determined (Figure 15a-d and column 37, line 10-column 41, line 11 of Rowe). Rowe also discloses that the portion of the thumbnail window corresponding to the part of the document being displayed is highlighted (emphasized) (column 12, lines 26-36 of Rowe). Rowe does not disclose that text entities are annotated according to style information if they are relevant to any of a plurality of concepts. However, Nielsen discloses a method in which a document is accessed and it is searched to identify text patterns that are relevant to user queries (plurality of concepts), which are

received from the user (column 1, line 17-column 2, line 16 of Nielsen). Nielsen discloses a method in which search terms are supplied via user queries and a document is searched to identify text patterns that match those search terms (column 1, line 17-column 2, line 16 of Nielsen). The text patterns that match the queries are then marked using tags and highlighted with color (annotated) to emphasize their position as the document is viewed (column 1, line 17-column 2, line 16 of Nielsen). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of viewing a document by Rowe with the method of searching a document by Nielsen because it would have provided a user with a simple way to search and identify terms when viewing a document.

In regard to independent claims 38 and 40-41, the claims incorporate substantially similar subject matter as claim 19. Thus, the claims are rejected along the same rationale as claim 19.

Response to Arguments

21. Applicant's arguments with respect to claims 1-2, 3-10, 14-16, 19-21, 23-29, 33-35, and 38-41 have been considered but are moot in view of the new ground(s) of rejection.

22. Applicant's arguments with respect to claims 11-13, 17-18, 30-32, and 36-37, presented on pages 21-23, have been considered but are not persuasive. As shown in the rejection above Rowe discloses a method in which contents (pages) are extracted and a thumbnail is created from those contents. Each set of contents (page) is

displayed in a continuous form on the thumbnail. As the claims are stated Rowe discloses every limitation in its broadest possible interpretation. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "dynamic thumbnail") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D Campbell whose telephone number is (571) 272-4133. The examiner can normally be reached on M-F (8:00 AM - 4:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

STEPHEN S. HONG
PRIMARY EXAMINER

JDC
September 10, 2004